



MS APPEAL BRIEF - PATENTS  
PATENT  
2091-0145P

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3600

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of Before the Board of Appeals  
Kazuo SHIOTA et al. Appeal No.:  
Appl. No.: 08/979,567 Group: 3621  
Filed: November 26, 1997 Examiner: C. HEWITT II  
Conf.: 5872  
For: PHOTOGRAPHIC PRINT ORDERING METHOD,  
SYSTEM, AND MEDIUM

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MS APPEAL BRIEF - PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

August 18, 2003

Sir:

Transmitted herewith is an Appeal Brief (in triplicate) on behalf of the Appellants in connection with the above-identified application.

The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

A Notice of Appeal was filed on June 19, 2003.

Applicant claims small entity status in accordance with 37 C.F.R. § 1.27

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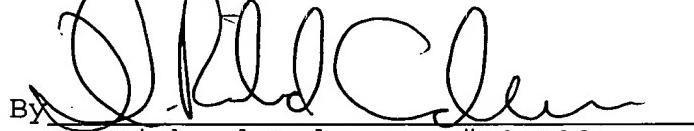
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Appl. No. 08/979,567

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Respectfully submitted,

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Attachment(s)

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IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

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Kazuo SHIOTA et al.

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Filed: November 26, 1997

Examiner: C. HEWITT II

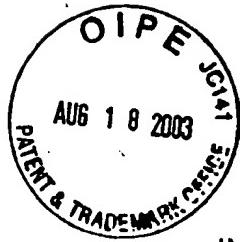
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TABLE OF CONTENTS

**GROUP 3600**

I.	REAL PARTY IN INTEREST .....	2
II.	RELATED APPEALS AND INTERFERENCES .....	2
III.	STATUS OF THE CLAIMS .....	2
IV.	STATUS OF AMENDMENTS .....	2
V.	SUMMARY OF THE INVENTION.....	2
VI.	GROUNDS OF REJECTION .....	5
VII.	ISSUES ON APPEAL .....	5
VIII.	GROUPING OF CLAIMS .....	6
IX.	ARGUMENT .....	7
A.	Argument Summary .....	7
B.	Specific Arguments Regarding the Prior Art Rejection.....	7
1.	Applicable Law Relating to Obviousness .....	7
2.	Independent Claims 1, 6, and 12.....	8
3.	Independent Claims 11 and 25.....	14
4.	Independent Claims 13, 19, and 26.....	17
5.	Independent Claim 27 .....	20
6.	Dependent Claims 3, 8, 15, and 21 .....	21
7.	Dependent Claims 28-33.....	22
X.	CONCLUSION.....	23
	APPENDIX – ClaimsAppealed .....	A-1



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ON BEHALF OF APPELLANTS KAZUO SHIOTA ET AL.

Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

August 18, 2003

Sir:

This is Appellants' Brief in the Appeal of the Examiner's Final Rejection dated February 25, 2003, in the above-identified application. A Notice of Appeal was timely filed on June 19, 2003.

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I. REAL PARTY IN INTEREST

The real party in interest for this application is the assignee, Fuji Photo Film Co., Ltd., 210 Nakanuma, Minamiashigara-shi, Kanagawa-ken, JAPAN.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences pending with respect to the subject matter of the present application.

III. STATUS OF THE CLAIMS

Claims 1-3, 5-8, 10-15, 17-21, and 23-33 remain pending, claims 4, 9, 16, and 22 having previously been canceled. Claims 1, 6, 11-13, 19, and 25-27 are independent. No claims have been allowed.

IV. STATUS OF AMENDMENTS

No amendments have been presented after the Final Rejection.

V. SUMMARY OF THE INVENTION

The invention of the subject application generally relates to photographic print ordering technology. In accordance with a print ordering technique described in the "Related Art" section of the present application, print ordering information is generated in accordance with a predetermined electronic data format when a customer interactively inputs print order instructions as printing service information is displayed on a display screen of a personal computer. [Page 1, line 24 – Page 2, line 8]. For

example, application software may generate a display that lists printing services, enabling the customer to refer to the displayed information to input print order instructions (e.g., specifying the number of prints) and stores the input print ordering information in a predetermined format to be subsequently accessed by a service provider, such as a development, print, and enlargement (DPE) shop or a photo-processing laboratory. [Page 1, lines 13-17; page 2, lines 3-8].

While the technique of the Related Art provides electronically-stored print ordering information to the service provider, without requiring manual input of the information by an operator, e.g., in accordance with a handwritten print order from the customer, the inventors of the present application have recognized drawbacks of the above-described Related Art technique arising from the fact that the type of printing services available to a customer often vary from service provider to service provider and may change over time, e.g., some services may be limited to certain holiday seasons or may be introduced to attract customers. [Page 2, lines 13-21]. Therefore, the application software of the Related Art, which is loaded on the customer's home computer to generate standard print ordering information, may result in a customer requesting a printing service that is not available and may prevent the customer from readily requesting a newly-offered printing service. [Page 2, lines 21-25].

Fig. 1 illustrates a photographic print ordering/fulfillment system according to an embodiment of the present invention. In this system, picture images recorded on developed film 1 are read by a film scanner 3 of a laboratory system 9, thereby generating digital picture images. The digital picture images are output to a digital printer 6 to generate a "first print" 10 according to a customer's instructions. Additionally,

the digitized picture images are recorded in a portable recording medium 2, such as a magneto-optical disk or a zip disk by an outputting drive 5. [Page 9, lines 4-14]. In addition to storing the high-resolution digital picture data on the portable recording medium 2, the laboratory system 9 records updateable printing service information in the portable recording medium 2, such printing service information indicating the printing services that can currently be provided by the service provider that has carried out the digital output service. This printing service information is service provider specific, such that different service providers will record different updateable printing service information on the portable recording medium 2. [Page 11, lines 13-18]. Such printing service information may include the various types of printing services offered by the service provider, the various printing sizes, charges, types of finishes, and special processing options, etc. [Page 9, line 15 – Page 10, line 23]. If the printing service information includes time-limited services, information relating to the term of validity of the service may be included in the information recorded on the portable recording medium 2. The name of the service provider or laboratory system 9 may also be included in the printing service information. [Page 9, lines 1-3].

Using the portable recording medium 2 and a personal computer 7, the customer may browse and edit picture images retrieved from the portable recording medium 2, as well as generate print ordering instructions as a menu (“order screen”) is displayed to reflect the previously-stored printing service information stored on the portable recording medium 2. [Page 12, lines 12-20]. As shown in Fig. 2, an updateable order screen 12, 13 is displayed to the user, in accordance with the original or updated printing service information recorded on the portable recording medium 2. Information input by the

customer, such as the number of prints per particular picture image, is formatted and recorded on the portable recording medium 2, which can subsequently be submitted to the service provider for generating requested prints in accordance with the recorded instructions. [Page 13, line 22 – page 14, line 2]. As illustrated in Fig. 2, a menu of services associated with picture image data may be updated when there is a change in printing service options available (see e.g., a comparison of order screens 12, 13 in Fig. 2). This technique facilitates both ordering of photographic image prints by the customer and processing by the laboratory system 9, including when the user requests prints from different service providers.

**VI. GROUNDS OF REJECTION**

The Examiner has rejected all pending claims as follows:

Claims 1-3, 5-8, 10-15, 17-21, and 23-33 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over *Moghadam et al.* (U.S. Patent 5,799,219, hereinafter “*Moghadam*”) in view of *Farros et al.* (U.S. Patent 5,930,810, hereinafter “*Farros*”).

**VII. ISSUES ON APPEAL**

The issues to be resolved in this Appeal are:

Whether the asserted grounds of rejection establishes *prima facie* obviousness of claims 1-3, 5-8, 10-15, 17-21, and 23-33 under 35 U.S.C. § 103 based on the asserted modification of *Moghadam* in view of *Farros*.

VIII. GROUPING OF CLAIMS

The claims should be grouped as follows for purposes of this Appeal:

- (1) Claims 1, 2, 5, 6, 7, 10/6, 10/7, and 12: Similar patentability arguments are presented for independent claims 1, 6, and 12, such that these claims stand or fall together. Furthermore, for purposes of this Appeal, dependent claims 2, 5, 7, 10/6 and 10/7 stand or fall with their respective base claim.
- (2) Claims 11 and 25: Similar patentability arguments are presented for independent claims 11 and 25, such that these claims stand or fall together. These claims are separately grouped and argued relative to the other claims.
- (3) Claims 13, 14, 17, 18, 19, 20, and 26: Similar patentability arguments have been presented for independent claims 13, 19, and 26, such that these claims stand or fall together. Furthermore, for purposes of this Appeal, dependent claims 14, 17, 18, and 20 stand or fall with their respective base claim. These claims are separately grouped and argued relative to the remaining claims.
- (4) Claim 27: Independent claim 27 is separately grouped and argued.
- (5) Claims 3, 8, 10/8, 15, and 21: Additional patentability arguments are presented for dependent claims 3, 8, 10/8, 15, and 21, such that these claims are separately grouped and argued relative to the remaining claims.
- (6) Claims 28-33: Additional patentability arguments are presented for dependent claims 28-33, such that these claims are separately grouped and argued.

## IX. ARGUMENT

### A. Argument Summary

The reasoning provided in support of the rejection of claims 1-3, 5-8, 10-15, 17-21, and 23-33 set forth in the Final Rejection dated February 25, 2003 fails to establish *prima facie* obviousness. Generally, the deficiencies of the rejection are that the Examiner's characterization of the primary reference, *Moghadam*, attributes features to the reference that a detailed reading of the reference reveals are neither taught nor suggested therein. The Examiner's reliance on a secondary reference, *Farros*, fails to make up for the deficiencies of *Moghadam*, such that the asserted combination fails to teach or suggest all limitations of the claims. Furthermore, there is no evidence to support the conclusion that one of ordinary skill in the art would have been motivated to modify the system of *Moghadam* in a manner that satisfies the features of the claimed invention. These deficiencies exist for the rejection of each of claims 1-3, 5-8, 10-15, 17-21, and 23-33.

### B. Specific Arguments Regarding the Prior Art Rejection

For at least reasons set forth in detail below, Appellants respectfully submit that the rejection under 35 U.S.C. § 103 based on the asserted combination of *Moghadam* and *Farros* fails to establish *prima facie* obviousness of any pending claim.

#### 1. Applicable Law Relating to Obviousness

To establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art and the asserted modification or combination of prior art must be supported by some teaching, suggestion, or motivation in the applied reference or in knowledge generally available to one skilled in the art. *In re Fine*, 837, F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); MPEP § 2143. Thus, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The prior art must suggest the desirability of the modification in order to establish a *prima facie* case of obviousness. *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995); MPEP § 2143.01. It can also be said that the prior art must collectively suggest or point to the claimed invention to support a finding of obviousness. *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986); *In re Ehrreich*, 590 F.2d 902, 908-09, 200 USPQ 504, 510 (CCPA 1979). The factual inquiry regarding whether motivation exists to combine references must be based on objective evidence. *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

## 2. Independent Claims 1, 6, and 12

### The Claimed Invention

Independent claim 1 is directed to a picture print ordering method for ordering a print of a picture image by generating print ordering information comprising electronic data in a predetermined standard to be processed by a predetermined photo finishing system. The picture print ordering method of claim 1 comprises: recording high resolution picture image data obtained by reading a developed film and printing service information regarding the printing service which can be provided for the high resolution picture image data in the same portable recording medium, the printing service information being updateable information for use in generating an updateable order screen displaying available printing services from which a user selects; displaying the

printing service information and the image data recorded in the portable recording medium so as to display the order screen when the print ordering information for requesting a printing service regarding the image data recorded in the portable recording medium is generated; and generating the print ordering information by using the displayed printing service information. Claim 1 specifies that the printing service information includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been recorded in the portable recording medium.

Thus, the picture print ordering method of claim 1 records high resolution picture image data and printing service information, which is updateable information for use in generating an updateable order screen displaying available printing services from which a user selects, on the same portable recording medium. As discussed above with regard to a disclosed embodiment of the present application, storing the "printing service information" in an updateable form on the recording medium along with the high resolution picture image data allows such information to be updated by the service provider upon fulfilling print orders, thereby enabling the user to subsequently generate print order information in accordance with the current printing capabilities of the service provider at the time of ordering prints. For example, as illustrated in Fig. 2, the updated printing service information recorded on the recording medium may be used to generate an updated menu ("order screen") of services associated with picture image data when there has been a change in printing service options available.

Independent claim 6 is directed to a picture print ordering system for ordering a print of a picture image by generating print ordering information comprising electronic

data in a predetermined standard to be processed by a predetermined photo finishing system. The picture print ordering system of claim 6 comprises: printing service information recording means which records high resolution picture image data obtained by reading a developed film and printing service information regarding the printing services which can be provided to the high resolution picture image data in the same portable recording medium, the printing service information being updateable information for use in generating an updateable order screen displaying available printing services from which a user selects; display means which displays the printing service information recorded in the portable recording medium and the image data so as to display the order screen when the print ordering information for requesting a printing service regarding the image data recorded in the portable recording medium is generated; input receiving means which receives input of a variety of instruction information using the displayed printing service information; and print ordering information generating means which generates the print ordering information by using the displayed printing service information received by the input receiving means. Claim 6 specifies that the printing service information includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been recorded in the portable recording medium.

Thus, system claim 6 recites the relevant functional aspects of method claim 1 discussed above.

Independent claim 12 is written in so-called *Beauregard* format, as being directed to a recording medium storing a program by means of which a computer generates print ordering information for ordering a print of a picture image, such print ordering

information comprising electronic data in a predetermined standard to be processed by a predetermined photo finishing system. The program stored in the recording medium of claim 12 comprises the steps of: displaying printing service information, the printing service information being updateable information for use in generating an updateable order screen displaying available printing services from which a user selects, and high resolution picture image data of the picture image recorded in the same portable recording medium on a display apparatus connected to the computer; enabling instruction information using the displayed printing service information to be inputted by a variety of input devices of the computer; and generating the print ordering information based on the instruction information input by the variety of input devices; wherein the printing service information includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been recorded in the portable recording medium.

Thus, claim 12 recites the relevant functional aspects of method claim 1 discussed above.

#### The Asserted Grounds of Rejection

As set forth in the rejection on pages 3-5 of the Office Action dated February 25, 2003, the Examiner relies on the primary reference, *Moghadam*, as allegedly teaching most features recited in claim 1. On page 4 of the Office Action, the Examiner concludes that, although *Moghadam* does not specifically describe storing high resolution image data, it would have been obvious to apply the system disclosed therein to such data. Furthermore, the Examiner states on page 4 of the Office Action that:

Although, a user of the *Moghadam* et al. system utilizes a plurality of print service related data in order to facilitate remote image

processing (column 6, lines 1-55; column 8, lines 1-26), it is not however, explicit as to whether this data is displayed to the user.

To make up for this deficiency, the Examiner relies on the secondary reference, *Farros*, and concludes on page 5 of the Office Action that:

[B]y implementing the system with visual verification and a receipt ('810. column 11, lines 22-67), a user of the *Moghadam* et al. system can provide evidence of service a request in the event of processing or payment errors.

#### Deficiencies in the Asserted Grounds of Rejection

*Moghadam* is clearly directed to a system for ordering digital prints remotely, via a network. As evident for example from the "Background" section of *Moghadam*, the system disclosed therein provides network-based interfacing with a film processing service provider so that the user and other authorized persons can access digitized versions of picture images via a network and communicate print ordering instructions. Fig. 4 illustrates an embodiment of *Moghadam*, in which a photo finishing center 50 includes an order entry station 30 ("retail counter"), a photo finishing workstation 42, a photographic printer 46, and a central computer 48, which includes digital image storage 44 and a communication channel 72 with a customer's home computer 68. In this embodiment, the home user accesses digital photographs stored at the central computer 48 as well as a digital index image 84 via the communication channel 72. The home user may print out the digital index image 84, hand write an order, and fax it to the photo finisher.

Consequently, since the technique disclosed by *Moghadam* is a network-based print ordering system, whereby the customer accesses print options remotely, the primary reference neither teaches nor suggests the principle of the claimed invention, in

which the “printing service information”, which is for use in generating an updateable order screen displaying available printing services from which a user selects, is updated using a portable recording medium, which also stores the high resolution image data.

By referencing col. 6, ll. 1-55 of *Moghadam* in relation to the claimed “printing service information,” the Examiner appears to equate this claimed updateable printing service information with information stored in the magnetic layer of the film 118 used in the *Moghadam* system. Appellants note, however, that such information in *Moghadam*, as evidenced for example at col. 6, ll. 31-33, is data recorded prior to the exposed film being sent to the photo finishing processor. Therefore, such information is not updateable information used in generating an updateable order screen displaying available printing service from which a user selects as required by independent claim 1.

The Examiner’s reliance on the secondary reference, *Farros*, fails to make up for this deficiency of *Moghadam*, and even if it would have somehow been obvious to modify the system of *Moghadam* as specified by the Examiner to include a visual display of *Farros* (which Appellants do not admit), such a system would still be a digital printing order system in which printing service information is accessed remotely via a network, not one that uses a portable recording medium that stores the high resolution picture data to update the printing service information so as to generate an updateable order screen displaying available printing services from which a user selects as required by independent claim 1.

Consequently, the asserted combination of *Moghadam* and *Farros* (assuming these references may be combined, which Appellants do not admit) fails to teach or suggest all features of claim 1. Furthermore, there is no evidence to support the

conclusion that one of ordinary skill in the art would have been motivated to modify the system of *Moghadam* in a manner that satisfies the features of the claimed invention.

This same reasoning supports the patentability of independent claims 6 and 12 over the asserted combination of *Moghadam* and *Farros*. Dependent claims 2, 5, 7, 10/6, and 10/7 define over the asserted combination of *Moghadam* and *Farros* at least based on reasoning set forth above with reference to their respective base claims.

### 3. Independent Claims 11 and 25

#### The Claimed Invention

Independent claim 11 is directed to a photo finishing system comprising image data obtaining means for obtaining high resolution picture image data, print ordering information obtaining means for obtaining print ordering information regarding the high resolution picture image data, and print generating means for carrying out a variety of printing processing based on the print ordering information. Independent claim 11 specifies that the print ordering information obtaining means obtains print ordering information generated using printing service information and the high resolution picture image data stored together in the same portable recording medium and displayed on a predetermined order screen as print services that can be provided for the high resolution picture image data. Claim 11 further specifies that the printing service information is updateable information for use in generating an updateable order screen displaying available printing services from which a user selects. The print generating means carries out a variety of printing processing for providing the printing services displayed as the printing service information, based on the print ordering information. The printing service information includes a plurality of attributes including size and kind

and the name of an apparatus and/or a service provider by which the printing service information has been displayed on the order screen and the photo finishing system associates updated printing service information with the image data to indicate current printing service capabilities of the print generating means.

Thus, the picture print ordering method of claim 1 records high resolution picture image data and printing service information, which is updateable information for use in generating an updateable order screen displaying available printing services from which a user selects, on the same portable recording medium.

Independent claim 11 requires that the photo finishing system associate updated printing service information with the image data, for storage on the portable recording medium, to indicate current printing service capabilities of the print generating means.

Independent claim 25 is directed to a photo finishing system that comprises: an image data obtaining unit which obtains high resolution picture image data from a user; a print ordering information obtaining unit which obtains print ordering information regarding the high resolution picture image data from the user; and a print generating unit which carries out a variety of printing processes based on the print ordering information. In claim 25, the print ordering information is generated using printing service information, the printing service information being updateable information for use in generating an updateable order screen displaying available printing services from which a user selects, and the high resolution picture image data, which is stored together with the printing service information on the same portable recording medium, displayed on a user device. The printing service information includes a plurality of attributes including size and kind and the name of an apparatus and/or a service

provider by which the printing service information has been recorded in the portable recording medium and the photo finishing system associates updated printing service information with the image data to indicate current printing service capabilities of the print generating unit. Therefore, claim 25 recites similar functional aspects to those of independent claim 11.

Deficiencies in the Asserted Rejection

As discussed in detail above, the print ordering system of *Moghadam* is a network-based print ordering system, whereby the customer's home computer 68 accesses print options remotely via a communication channel 72. Thus, the primary reference neither teaches nor suggests the principle of the claimed invention, in which the "printing service information", which is for use in generating an updateable order screen displaying available printing services for the high resolution image data, is stored on a portable recording medium, which also stores the high resolution image data. Furthermore, Appellants submit that these claims clearly distinguish over the asserted combination of *Moghadam* and *Farros* by explicitly stating that updated printing service information associated with the image data recorded in the portable recording medium indicates "current printing service capabilities" of a print generating means/unit. As noted above, the customer in the *Moghadam* system accesses information for generating a print order via a network.

At least for these reasons, the rejection fails to establish *prima facie* obviousness of independent claim 11 or 25.

4. Independent Claims 13, 19, and 26

The Claimed Invention

Independent claim 13 is directed to a picture print ordering method comprising the steps of: recording high resolution picture image data, obtained by reading a developed film, and printing service information regarding printing services, which can be provided for the high resolution picture image data, on the same portable recording medium by a photo finishing system, the printing service information being updateable information for use in generating an updateable order screen displaying available printing services from which a user selects; displaying the printing service information and the high resolution picture image data from the portable recording medium at a user device; and generating print ordering information identifying print services desired for the high resolution picture image data at the user device, using the displayed printing service information. In claim 13, the printing service information includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been recorded in the portable recording medium.

Thus, the picture print ordering method of claim 13 records high resolution picture image data and printing service information, which is updateable information for use in generating an updateable order screen displaying available printing services from which a user selects, on the same portable recording medium.

Independent claim 19 is directed to a picture print ordering system comprising: a first recording unit for recording high resolution picture image data, obtained by reading a developed film, and printing service information regarding printing services which can

be provided for the high resolution picture image data on the same portable recording medium by a photo finishing system, the printing service information being updateable information for use in generating an updateable order screen displaying available printing services from which a user selects; a display unit for displaying the printing service information and the high resolution picture image data from the portable recording medium at a user device; and a generating unit for generating print ordering information identifying print services desired for the high resolution picture image data at the user device, using the displayed printing service information. In claim 19, the printing service information includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been displayed. Thus, the functional recitations in claim 19 essentially correspond to features of method claim 13.

Independent claim 26 is written in so-called *Beauregard* format, reciting a computer program embodied on a computer-readable medium for ordering prints, comprising: a recording source code segment for recording full image picture data, obtained by reading a developed film, and printing service information regarding printing services which can be provided for the high resolution picture image data on the same portable recording medium by a photo finishing system, the printing service information being updateable information for use in generating an updateable order screen displaying available printing services from which a user selects; a displaying source code segment for displaying the printing service information and the high resolution picture image data from the portable recording medium at a user device; and a generating source code segment for generating print ordering information identifying

print services desired for the high resolution picture image data at the user device, using the displayed printing service information; wherein the printing service information includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been recorded in the portable recording medium.

Deficiencies in the Rejection

As discussed in detail above, the print ordering system of *Moghadam* is a network-based print ordering system, whereby the customer's home computer 68 accesses print options remotely via a communication channel 72.

Accordingly, since the technique disclosed by *Moghadam* is a network-based print ordering system, the primary reference neither teaches nor suggests the principle of the invention recited in claims 13, 19, and 26, in which the "printing service information", which is for use in generating an updateable order screen displaying available printing services from which a user selects, is updated using a portable recording medium, which also stores the high resolution image data.

The Examiner's reliance on the secondary reference, *Farros*, fails to make up for this deficiency of *Moghadam*, and even if the system of *Moghadam* were modified as specified by the Examiner to include a visual display of *Farros* (which Applicants do not admit), such a system would still be a digital printing order system in which printing service information is network-based, not using a portable recording medium to update the printing service information so as to generate an updateable order screen displaying available printing services from which a user selects as required by independent claims 13, 19, and 26.

Dependent claims 14, 17, 18, and 20 define over the asserted combination of *Moghadam* and *Farros* at least based on reasoning set forth above with reference to their respective base claims.

### 5. Independent Claim 27

#### The Claimed Invention

Claim 27 is directed to a medium (i.e., an article of manufacture) that comprises: a first recording area for recording picture image data with high resolution; and a second recording area for recording information regarding printing services, the printing service information being updateable information for use in generating an updateable order screen displaying available printing services from which a user selects. In claim 27, the picture image data with high resolution and the information regarding printing services are provided together to a customer, the customer ordering a print out according to the information regarding printing services and the picture image data with high resolution. The information regarding printing services includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been produced. The medium is a portable recording medium, such that the high resolution image data and the printing service information are stored on the same portable recording medium.

Deficiencies in the Prior Art Rejection

As discussed in detail above, the print ordering system of *Moghadam* is a network-based print ordering system, whereby the customer's home computer 68 accesses print options remotely via a communication channel 72.

Thus, since the technique disclosed by *Moghadam* is a network-based print ordering system, the primary reference neither teaches nor suggests the principle of the invention recited in independent claim 27, in which the "printing service information", which is for use in generating an updateable order screen displaying available printing services from which a user selects, is updated using a portable recording medium, which also stores the high resolution image data.

The Examiner's reliance on the secondary reference, *Farros*, fails to make up for this deficiency of *Moghadam*, and even if the system of *Moghadam* were modified as specified by the Examiner to include a visual display of *Farros* (which Applicants do not admit), such a system would still be a digital printing order system in which printing service information is network-based, not using a portable recording medium to update the printing service information so as to generate an updateable order screen displaying available printing services from which a user selects as required by independent claim 27.

6. Dependent Claims 3, 8, 15, and 21

Dependent claims 3, 8, 15, and 21 each further limit their respective base claim by specifying that "the printing service information includes information regarding the available time period of the printing services." Thus, the invention recited in these dependent claims allows the service provider to include an indication of services that

are time-limited, such as services provided only for certain holiday seasons, via the portable recording medium that stores the high resolution image data. Such a feature is neither taught nor suggested by the applied prior art.

7. Dependent Claims 28-33

Dependent claims 28-33 each further limit their respective base claim by specifying that "the printing service information is updated printing service information for updating the order screen and/or deleting a service which cannot be provided to the user from the order screen." As shown for example in Fig. 2 of the present application, the updated printing service information provided to the user on the portable recording medium, along with the high resolution picture image data, may be used to generate an updated print order screen, which differs from a previously-presented order screen used by the customer to generate the previous print order. Although the Examiner relies on the secondary reference, *Farros*, as allegedly teaching the use of a display for an updateable order screen, Appellants submit that *Farros* relates to providing services for a predetermined system, and does not teach or suggest storing the high resolution picture image information and updateable order service menu information on a portable recording medium as required by these dependent claims. Furthermore, even if the system of *Moghadam* were modified as specified by the Examiner to include a visual display such as that of *Farros*, such a system would still be a digital printing order system in which printing service information is provided to the customer via a network, not by using a portable recording medium to update the printing service information so as to update an order screen and/or delete a service which cannot be provided to the user from the order screen as required by dependent claims 28-33.

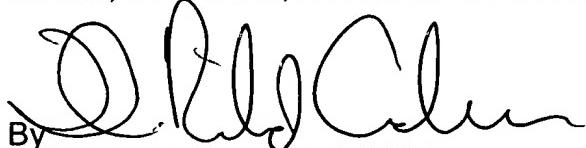
At least for the above-stated reasons, Appellants respectfully submit that the Office Action fails to establish *prima facie* obviousness of any pending claim.

X. CONCLUSION

For at least the reasons specifically set forth above, Appellants respectfully request that the outstanding rejection of all pending claims set forth in the Final Office Action be reversed.

Respectfully submitted,

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APPENDIX - CLAIMS APPEALED

1. (Previously Presented) A picture print ordering method which orders a print of a picture image by generating print ordering information comprising electronic data in a predetermined standard to be processed by a predetermined photo finishing system, comprising the steps of:

recording high resolution picture image data obtained by reading a developed film and printing service information regarding the printing service which can be provided for the high resolution picture image data in the same portable recording medium, said printing service information being updateable information for use in generating an updateable order screen displaying available printing services from which a user selects;

displaying the printing service information and the image data recorded in the portable recording medium so as to display said order screen when the print ordering information for requesting a printing service regarding the image data recorded in the portable recording medium is generated; and

generating the print ordering information by using the displayed printing service information;

wherein the printing service information includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been recorded in the portable recording medium.

2. (Original) A picture print ordering method as defined in Claim 1 wherein the printing service information includes the sizes in which a print can be generated and the service charges therefor.

3. (Previously Presented) A picture print ordering method as defined in Claim 1 wherein the printing service information includes information regarding the available time period of the printing services.

5. (Original) A picture print ordering method as defined in any one of Claims 1 to 4 wherein the printing service information includes information showing the kinds of finishing processing which can be carried out on the picture image when the picture image is printed.

6. (Previously Presented) A picture print ordering system which orders a print of a picture image by generating print ordering information comprising electronic data in a predetermined standard to be processed by a predetermined photo finishing system, comprising:

printing service information recording means which records high resolution picture image data obtained by reading a developed film and printing service information regarding the printing services which can be provided to the high resolution picture image data in the same portable recording medium, said printing service information being updateable information for use in generating an updateable order screen displaying available printing services from which a user selects;

display means which displays the printing service information recorded in the portable recording medium and the image data so as to display said order screen when

the print ordering information for requesting a printing service regarding the image data recorded in the portable recording medium is generated;

input receiving means which receives input of a variety of instruction information using the displayed printing service information; and

print ordering information generating means which generates the print ordering information by using the displayed printing service information received by the input receiving means;

wherein the printing service information includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been recorded in the portable recording medium.

7. (Original) A picture print ordering system as defined in Claim 6 wherein the printing service information includes the sizes in which a print can be generated and the service charges therefor.

8. (Previously Presented) A picture print ordering system as defined in Claim 6 wherein the printing service information includes information regarding the available time period of the printing services.

10. (Original) A picture print ordering system as defined in any one of Claims 6 to 9 wherein the printing service information includes information showing the kinds of finishing processing which can be carried out on the picture image when the picture image is printed.

11. (Previously Presented) A photo finishing system comprising image data obtaining means which obtains high resolution picture image data, print ordering information obtaining means which obtains print ordering information regarding the high resolution picture image data, and print generating means which carries out a variety of printing processing based on the print ordering information, wherein

the print ordering information obtaining means obtains print ordering information generated using printing service information and the high resolution picture image data stored together in the same portable recording medium and displayed on a predetermined order screen as print services which can be provided for the high resolution picture image data, said printing service information being updateable information for use in generating an updateable order screen displaying available printing services from which a user selects, and

the print generating means carries out a variety of printing processing for providing the printing service displayed as the printing service information, based on the print ordering information;

wherein the printing service information includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been displayed on the order screen and the photo finishing system associates updated printing service information with the image data to indicate current printing service capabilities of the print generating means.

12. (Previously Presented) A recording medium wherein a program is stored by means of which a computer generates print ordering information in order to order a print of a picture image, said print ordering information comprising electronic data in a predetermined standard to be processed by a predetermined photo finishing system, the program comprising the steps of:

displaying printing service information, said printing service information being updateable information for use in generating an updateable order screen displaying available printing services from which a user selects, and high resolution picture image data of the picture image recorded in the same portable recording medium on a display apparatus connected to the computer;

enabling instruction information using the displayed printing service information to be inputted by a variety of input devices of the computer; and

generating the print ordering information based on the instruction information input by the variety of input devices;

wherein the printing service information includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been recorded in the portable recording medium.

13. (Previously Presented) A picture print ordering method comprising the steps of:

recording high resolution picture image data, obtained by reading a developed film, and printing service information regarding printing services, which can be provided for the high resolution picture image data, on the same portable recording medium by a

photo finishing system, said printing service information being updateable information for use in generating an updateable order screen displaying available printing services from which a user selects;

displaying the printing service information and the high resolution picture image data from the portable recording medium at a user device; and

generating print ordering information identifying print services desired for the high resolution picture image data at the user device, using the displayed printing service information;

wherein the printing service information includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been recorded in the portable recording medium.

14. (Previously Presented) A picture print ordering method as defined in claim 13, wherein the printing service information includes the sizes in which a print can be generated and the service charges therefor.

15. (Previously Presented) A picture print ordering method as defined in claim 13, wherein the printing service information includes information regarding the available time period of the printing service.

17. (Previously Presented) A picture print ordering method as defined in claim 13, wherein the printing service information includes information showing the kinds of finishing processing which can be carried out on the picture image when the picture image is printed.

18. (Previously Presented) The picture print ordering method of claim 13, further comprising the steps of:

recording the print order information on the recording medium at the user device, and

supplying the recording medium to the photofinishing system to produce prints in accordance with the print order information.

19. (Previously Presented) A picture print ordering system comprising:

a first recording unit for recording high resolution picture image data, obtained by reading a developed film, and printing service information regarding printing services which can be provided for the high resolution picture image data on the same portable recording medium by a photo finishing system, said printing service information being updateable information for use in generating an updateable order screen displaying available printing services from which a user selects;

a display unit for displaying the printing service information and the high resolution picture image data from the portable recording medium at a user device; and

a generating unit for generating print ordering information identifying print services desired for the high resolution picture image data at the user device, using the displayed printing service information;

wherein the printing service information includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been displayed.

20. (Previously Presented) A picture print ordering system as defined in claim 19, wherein the printing service information includes the sizes in which a print can be generated and the service charges therefor.

21. (Previously Presented) A picture print ordering system as defined in claim 19, wherein the printing service information includes information regarding the available time period of the printing services.

23. (Previously Presented) A picture print ordering system as defined in claim 19, wherein the printing service information includes information showing the kinds of finishing processing which can be carried out on the picture image when a picture image is printed.

24. (Previously Presented) The picture print ordering system of claim 19, further comprising:

a second recording unit for recording the print order information on the recording medium at the user device; wherein

the recording medium is supplied to the photofinishing system to produce prints in accordance with the print order information.

25. (Previously Presented) A photo finishing system comprising:

an image data obtaining unit which obtains high resolution picture image data from a user;

a print ordering information obtaining unit which obtains print ordering information regarding the high resolution picture image data from the user; and

a print generating unit which carries out a variety of printing processes based on the print ordering information, wherein the print ordering information is generated using printing service information, said printing service information being updateable information for use in generating an updateable order screen displaying available printing services from which a user selects, and the high resolution picture image data, which is stored together with the printing service information on the same portable recording medium, displayed on a user device;

wherein the printing service information includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been recorded in the portable recording medium and the photo finishing system associates updated printing service information with the image data to indicate current printing service capabilities of the print generating unit.

26. (Previously Presented) A computer program embodied on a computer-readable medium for ordering prints comprising:

a recording source code segment for recording full image picture data, obtained by reading a developed film, and printing service information regarding printing services which can be provided for the high resolution picture image data on the same portable recording medium by a photo finishing system, said printing service information being updateable information for use in generating an updateable order screen displaying available printing services from which a user selects;

a displaying source code segment for displaying the printing service information and the high resolution picture image data from the portable recording medium at a user device; and

a generating source code segment for generating print ordering information identifying print services desired for the high resolution picture image data at the user device, using the displayed printing service information;

wherein the printing service information includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been recorded in the portable recording medium.

27. (Previously Presented) A medium comprising:

a first recording area for recording picture image data with high resolution; and

a second recording area for recording information regarding printing services, said printing service information being updateable information for use in generating an updateable order screen displaying available printing services from which a user selects, wherein the picture image data with high resolution and the information regarding printing services are provided together to a customer;

the customer ordering a print out according to the information regarding printing services and the picture image data with high resolution;

wherein the information regarding printing services includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been produced, and

wherein said medium is a portable recording medium, such that the high resolution image data and the printing service information are stored on the same portable recording medium.

28. (Previously Presented) The picture print ordering method according to claim 1, wherein the printing service information is updated printing service information for updating the order screen and/or deleting a service which cannot be provided to the user from the order screen.

29. (Previously Presented) The picture print ordering system according to claim 6, wherein the printing service information is updated printing service information for updating the order screen and/or deleting a service which cannot be provided to the user from the order screen.

30. (Previously Presented) The picture print ordering method according to claim 13, wherein the printing service information is updated printing service information for updating the order screen and/or deleting a service which cannot be provided to the user from the order screen.

31. (Previously Presented) The picture print order system according to claim 19, wherein the printing service information is updated printing service information for updating the order screen and/or deleting a service which cannot be provided to the user from the order screen.

32. (Previously Presented) The invention according to claim 26, wherein the printing service information is updated printing service information for updating the order screen and/or deleting a service which cannot be provided to the user from the order screen.

33. (Previously Presented) The invention according to claim 27, wherein the information regarding printing services is updated information for updating the order screen and/or deleting a service which cannot be provided to the user from the order screen.